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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,013	06/28/2005	Eric Henderson	016348-9048-US00	9052
23510 7590 06/05/2007 MICHAEL BEST & FRIEDRICH, LLP ONE SOUTH PINCKNEY STREET P O BOX 1806 MADISON, WI 53701			EXAMINER LAM, ANN Y	
			ART UNIT 1641	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,013	<b>Applicant(s)</b> HENDERSON ET AL.	
	<b>Examiner</b> Ann Y. Lam	<b>Art Unit</b> 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-17 and 28-42 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 38-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-13, 28, 30-32 and 34-36 is/are rejected.
- 7) ☒ Claim(s) 3, 29, 33 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6-13, 28, 30-32, 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Agrawal et al., 7,195,872.

As to claims 1, 9, 10 and 28, Applicants claim an apparatus comprising a probe comprising a pointed member having a plurality of domains forming an array. Since Applicants specification does not limit an "array" or "domain" to molecular or biological species (but rather includes but is not limited to molecular and biological species), the device disclosed by Agrawal et al. in figure 8 discloses the recited limitations, wherein microstructure elements (802) are deemed to be the recited domains forming an array on a probe, wherein the probe is the pointed member on which elements (802) are formed.

As to claim 2, the microstructure elements are deemed to be a nanoarray.

AS to claim 4, the domains (microstructures) are deemed to include nanosensors (e.g., fluorescent labels, see col. 8, lines 9-10.)

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As to claims 6 and 7, since Applicants have not recited in the claims nor defined in the specification as to what constitutes the recited element, the probe is considered to be a dual element or multielement probe, the elements being the microstructures or fluorescent labels, and there are at least two microstructures or fluorescent labels.

As to claim 8, the probe is sized such that it is capable of interrogating the volume of sample recited.

As to claims 11, 34 and 35, the Agrawal et al. substrate is formed of glass, which is hydrophobic or anti-wicking.

As to claims 12 and 13, Agrawal et al. disclose an optical detection technique or mass spectrometer.

As to claims 30-32, the probe is sized such that it is capable of interrogating the materials recited by Applicants.

As to claim 36, the fluorescent label (col. 8, lines 9-10) is deemed to be the claimed substance.

### ***Allowable Subject Matter***

Claims 3, 29, 33 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***


Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection. Upon reconsideration, the Lal et al. reference does not appear to disclose a probe having an array and sized for insertion into a cell as recited in claim 30, and thus, the present Office action is made non-final. In view of the cancellation of "tip" in claim 1, new grounds for rejection is made for claim 1 as well as other claims indicated above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on Mon.-Fri. 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ANN YEN LAM  
PATENT EXAMINER